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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,883	03/31/2004	Iain Kalfas	DUQ-002 (DEP5290)	9073

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LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER	
REIMERS, ANNETTE R	
ART UNIT	**PAPER NUMBER**
3733	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/815,883	KALFAS ET AL.	
	Examiner	Art Unit	
	Annette R. Reimers	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 September 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because the abstract is too long. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Simonson (US Patent Number 5,643,263).

Simonson discloses a connector for connecting a first rod, 88, and a second rod, 80, comprising a housing component defining a first bore hole, 26, for receiving a portion of the first rod, the first bore hole extending along a first longitudinal axis and a second bore hole, 22, for receiving a portion of the second rod, the second bore hole extending along a second longitudinal axis and a locking element, 60 and 96, for securing one of the first rod within the first bore hole and the second rod within the second bore hole, wherein the first longitudinal axis is configured to be offset in a sagittal plane from the second longitudinal axis by a variable predetermined offset distance when the connector is implanted in a patient (see figures 6-9). Furthermore, the first housing component includes a first set of external teeth, 72, on an outer surface and the second housing component includes a second set of external teeth, 72, on an outer surface thereof configured to interlock with the first set of teeth at a plurality of discrete positions (see figure 8 and column 3, lines 32-47). The second housing component includes a coupling rod, 30, extending in a direction that is transverse to the second bore hole and the first housing component includes a coupling hole, 32, configured to receive the coupling rod (see figure 1). The coupling rod can include a first set of teeth on an outside surface and the coupling hole can include a second set of teeth on an inside surface configured to interlock with the first set of teeth (see column 2, lines 32-54). The connector further comprises a clamping mechanism, 48 and 52, for securing the first housing component in a selected position relative to the second

housing component and a spherical bushing, 40, in the second bore hole for moving the second bore hole to adjust an angle of the second rod relative to the first rod (see figures 1-2). The connector also has a top-loading set screw, 24, for securing both the first rod and the second rod (see figure 1, 6 and 8). Regarding method claims 21-26, the connector device of Simonson is capable of performing the method of connecting a first rod to a second rod.

With regard to statements of intended use and other functional statements, e.g. for connecting a first rod and a second rod, they do not impose any structural limitations on the claims distinguishable over Simonson, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Taylor (US Patent Number 6,685,705).

Taylor discloses various embodiments of a connector for connecting a first rod, B, and a second rod, A, comprising a housing component defining a first bore hole, 8, for receiving a portion of the first rod, the first bore hole extending along a first

longitudinal axis and a second bore hole, 6, for receiving a portion of the second rod, the second bore hole extending along a second longitudinal axis and a locking element, 3 and 5, for securing one of the first rod within the first bore hole and the second rod within the second bore hole, wherein the first longitudinal axis is configured to be offset in a sagittal plane from the second longitudinal axis by a variable predetermined offset distance when the connector is implanted in a patient (see figure 1). Furthermore, the first housing component includes a first set of external teeth on an outer surface and the second housing component includes a second set of external teeth on an outer surface thereof configured to interlock with the first set of teeth at a plurality of discrete positions (see figures 6-9). The second housing component includes a coupling rod, 10, extending in a direction that is transverse to the second bore hole and the first housing component includes a coupling hole, 9, configured to receive the coupling rod (see figures 1-3). The coupling rod can include a first set of teeth on an outside surface and the coupling hole can include a second set of teeth on an inside surface configured to interlock with the first set of teeth (see figures 1-3). The connector further comprises a clamping mechanism for securing the first housing component in a selected position relative to the second housing component and a spherical bushing, 33, in the second bore hole for moving the second bore hole to adjust an angle of the second rod relative to the first rod (see figures 8-9). The connector also has a top-loading set screw, 40, for securing both the first rod and the second rod (see figure 8). Regarding method claims 21-26, the connector device of Taylor is capable of performing the method of connecting a first rod to a second rod.

With regard to statements of intended use and other functional statements, e.g. for connecting a first rod and a second rod, they do not impose any structural limitations on the claims distinguishable over Taylor, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Response to Arguments

Applicant's arguments filed on February 16, 2006 have been fully considered, but they are not persuasive. In response to applicant's argument that the Simonson reference and the Taylor reference are not directed to connecting a first rod and a second rod, but rather to a connection assembly for connecting a spinal rod to a spinal implant bolt and a connection assembly for connecting a spinal rod to a fixation device, respectively, it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be

employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

In this case, both the Simonson and the Taylor references meet the claimed structural limitation. Furthermore, both the Simonson and the Taylor references are capable of performing the function of connecting a first rod to a second rod. Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

In addition, the recitation of "a connector for connecting a first rod and a second rod," in the preamble, has not been given patentable weight, because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER